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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



In re Application of

Atty. Docket

JACOBUS W. VALLEN

PHN 16,749

Serial No. 09/224,913

Group: 2832

Filed: JANUARY 4, 1999

Examiner: T. NGUYEN

Title: ELECTRIC BALLAST

Commissioner for Patents
Washington, D.C. 20231

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Sir:

Transmitted herewith is an original and two copies of
a Reply Brief in the above-identified patent application.

Respectfully submitted,

By Bernard Franzblau
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By Bernard Franzblau
(Signature)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
In Application of

JACOBUS W. VALLEN

Atty. Docket # 17 2501

PHN 16,749 2800 MAIL ROOM

Serial No. 09/224,913

Group Art Unit: 2832

Filed: January 4, 1999

Examiner: T. Nguyen

Title: ELECTRIC BALLAST

Commissioner for Patents
Washington, D.C. 20231

REPLY BRIEF

Sir:

This is a Reply Brief in response to the Examiner's Answer in this application and which is dated 5/23/01.

At the outset, Applicant submits that the Examiner's Answer presents little if any factual support for the rejections under 35 U.S.C. §112, second paragraph, and 35 U.S.C. §103(a) and therefore the Answer does not satisfy the burden of proof placed on the Patent and Trademark Office and which is required for valid rejections under these Sections of the statute.

Applicant furthermore protests the manner in which the Patent and Trademark Office has rejected claims 3-5 under 35 U.S.C. §112, second paragraph. After Applicant argued against the "112" rejection based upon the use of the word "substantially" in his amendment under 37 C.F.R. §1.116, filed 10/16/00, an Advisory Action (dated 11/3/00) was received entering said amendment but with no indication as to the status of the "112" rejections. Applicant then filed a Petition (dated 11/10/00) requesting a new Advisory Action clarifying the status of the "112" rejections, and

if such rejections were maintained, an explanation why the aforesaid amendment does not overcome the "112" rejections. A second Advisory Action dated 1/12/01 was received by Applicant stating that Applicant's Response had overcome the "112 second paragraph rejection". Prior to receipt of the secondary Advisory Action, Applicant filed an Appeal Brief (dated 1/5/01) which argued, *inter alia*, why the rejections under 35 U.S.C. §112, second paragraph, were invalid. Accompanying the Examiner's Answer (dated 5/23/01) was a third Advisory Action which now advised that the "112" rejection based upon the "whereby" clause was withdrawn but the rejection based on the term "substantially" was maintained. This latter statement is at odds with the Patent and Trademark Office position on the "112" rejections in the secondary Advisory Action, i.e. that Applicant's response had overcome the "112" second paragraph rejection. The aforesaid Patent and Trademark Office procedure related to the "112" rejections of claims 3-5 is improper, and is detrimental to Applicant's right to a fair and complete examination of his application.

Applicant further notes that the Examiner's Answer is silent as to the rejection under 35 U.S.C. §112, second paragraph, except in his "Response to Argument", paragraph (11) of the Answer, where he states, as to the "112" rejection based on the term "substantially", "the 'substantially' term rejection under 112, second paragraph is maintained because, the term 'substantially' is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of

the invention." This statement by the Examiner is a mere statement of his opinion without a shred of factual support therefor. The "112" rejection is clearly invalid because the Examiner's Answer does not satisfy the Patent and Trademark Office burden of proof on the "112" issue involved in this appeal.

As to Applicant's prior argument that the term "substantially" has received widespread recognition and acceptance by the Patent and Trademark Office, see, for example, USP 4,235,302 (claim 1 - "substantially lower than"); USP 3,648,153 (claim 1 - "substantially constant current source"); USP 3,782,258 (claims 1 and 2 - "substantially impedance-free connection"); USP 3,864,532 (claim 8 - "substantially non-reactance elements"); and USP 4,361,735 (claim 1 - "substantially no resistance", claim 11 - "substantially greater than").

Furthermore, in the CAFC case of In re Mattison and Swanson, 184 USPQ 84, the Court found that the term "substantially increase the efficiency" etc. satisfied both Section 1 and Section 2 of 35 U.S.C. §112. The Court reasoned that 35 U.S.C. §112, second paragraph, was satisfied because the specification provided general guidelines for the term. More particularly, if the claimed modification of the prior art compound achieved Applicant's object of substantially increased efficiency of the prior art compound, then such a modified compound is within the scope of the claims and 35 U.S.C. §112, second paragraph, is satisfied.

In the present case, the specification clearly indicates what Applicant intends to achieve by his invention, i.e. to overcome certain defects in the prior art electric ballast described in EP-0

018 596 (see page 1 of application). Applicant's aim is to provide an electric ballast with a separate one-piece synthetic resin body which externally encloses the coil winding such that the prior art (EP-0 018 596) folding seams in the synthetic resin of the base part are no longer necessary (page 1 of application).

The advantages of Applicant's invention are extensively discussed in the application at page 1, lines 23-29 and all of page 2 thereof. One object of the invention is to "enclose the coil windings" (see page 3, lines 31-33, page 4, lines 6-7 and lines 20-21). The purpose of the term "substantially" is to ensure that small, inconsequential gaps in the coil enclosing function by a potential infringer do not avoid the patent, while achieving the advantages thereof. Thus, it is clear that any structure which achieves the disclosed objects and advantages of the invention, e.g. improved insulation function, small volume of the ballast, a cheaper manufacturing process, etc. (see pages 1-2 of the application), fall within the scope of the claims. In accordance with the CAFC decision in the Mattison et al case, the specification of this application makes the use of the term "substantially" clear and definite within the demands of 35 U.S.C. §112, second paragraph. This is especially true since the Examiner's Answer does not provide any contrary factual support for his unsupported opinion on this issue.

Turning now to the "103" rejection of claims 5 and 3, in paragraph (11) of the Answer, as to Applicant's argument [3] regarding non-analogous art of the applied references, the Examiner relies on the case of In re Oetiker, 24 USPQ 2d 1443 and the

argument that "Applicant has not claimed any specific structure regarding the application of the winding assembly, but rather the winding assembly itself." This is incorrect since independent claim 5 calls for an "electric ballast" and page 1 of the application indicates that the invention is related to a ballast for an electric gas discharge lamp. Electric ballasts are required to have special characteristics because of the peculiar nature of the load they feed, i.e. an electric gas discharge lamp which has a negative resistance characteristic and requires a high ignition voltage and a much lower operating voltage. Thus, the Patent and Trademark Office argument in Section [3] of paragraph (11) is wrong since claims 5 and 3 claim a specific structure of an electric ballast, not a mere general purpose winding assembly, as alleged in the Examiner's Answer.

Aside from the fact that neither Witchger or Sugiura et al disclose anything at all to suggest that either of these references have characteristics that would be useful as part of an electric ballast, the objects and advantages of each apparatus have nothing at all to do with the requirements of an electric ballast and so one skilled in the art who is tasked with the design of an electric ballast would not consult either reference for guidance. Even if these references were considered, neither suggests that either apparatus would be useful as an electric ballast because the descriptions thereof provide no hint that they could efficiently operate a gas discharge lamp in the manner required of an "electric ballast".

Furthermore, the invention in the Witchger patent is directed to a particular problem in the manufacture of electric coils, which it solves by attaching current supply leads to a single strip of dielectric material strip attachable to a coil without use of adhesive, more particularly to the use of a flexible dielectric strip (31) with an aperture (33) at one end and with an arrowhead (32) with notches 41, 42 in order to facilitate fastening the strip (31) in a manner that will enclose the coil winding. This is the *raison d'etre* of the Witchger patent. To modify same as suggested by the Examiner, that is by the use of the Sugiura et al cover 20 with terminal housing 21 in the Witchger apparatus would obviate the need for the Witchger tape and non-adhesive fastening feature. The Examiner's proposed modification of the Witchger invention would be contrary to the purpose and objects of Witchger and so it would not be obvious to make this proposed substitution since such a modification would destroy the Witchger invention for its above described intended purpose, see Ex Parte Thompson, 184 USPQ 558. Thus, not only would it not be obvious to use either applied reference in an electric ballast, but it also would not be obvious to combine Sugiura et al with Witchger in the manner proposed by the Examiner.

As to the Oetiker case cited by the Examiner in his Answer, this case in fact supports Applicant's argument for patentability. As noted by the Examiner, this case holds that in order for a prior art reference to be relied upon as a basis for rejecting an Applicant's claimed invention, the prior art reference must either be in the field of Applicant's endeavor or, if not, then be

reasonably pertinent to the particular problem with which the Applicant was concerned. The applied references are clearly not in the field of electric ballasts and are not at all pertinent to the particular problems of this prior art, much less the particular problem in this art to which the present invention is directed, i.e. to the disadvantages of the electric ballast in the prior art patent, EP-0 018 596 (see page 1 of application).

Turning to Section [4] of paragraph (11) of the Answer (page 7 thereof), there is no factual support presented for the Examiner's opinion statement that a "skilled artisan would have been highly motivated to combine the one piece teaching of Sugiura et al with the cover design of Witchger". This statement is therefore without merit.

As to Section [5] of paragraph (11) of the Answer (see page 7), all it does is describe features of the two applied references. There is nothing in this statement to provide a motivation for combining same, or for the use thereof as an electric ballast. This section of the Answer has no prima facie value.

The Examiner in Section [6] of paragraph (11) unfortunately has not understood the Thompson decision set out at page 10 of the Appeal Brief. The Thompson decision does not hold that the Patent and Trademark Office combination would destroy the apparatus of the modified reference. The holding there was that the Patent and Trademark Office proposed modification of the second reference would destroy the apparatus of this second reference for its intended purpose, i.e. such a modified second reference would prevent the patentee of the second reference from achieving the

objects and purpose of his invention. So too in this case, the substitution of the Sugiura et al casing (20) with terminal housing (21) for the Witchger flexible tape 31 (with aperture 33 and elements 32, 41, 42) would result in a modified Witchger apparatus that would not solve the prior art problems which Witchger intended to solve, and certainly not in the manner set out in Witchger's summary of the invention (col. 1, lines 33-39) and in the claims of his patent.

The Examiner's Answer does not present the factual evidence necessary to support a prima facie case of obviousness as to claim 5.

As to claim 3, Section [7] of paragraph (11) of the Answer (see page 8) relies on column 3, lines 27-35 of Witchger in order to support the argument that the applied prior art teaches end portions of the cover connected with each other. This is not so. The cited material connects the end 32 of strip 31 with aperture 33 which is at the same end of the strip. Aperture 33 is not in the other end of strip 31 (see the break in strip 31 in Figs. 8 and 9). In fact, the other end 34 of strip 31 is secured in place "by applying a complete circle of tape 48 around the outside of the assembly" (c.f. col. 4, lines 2-4 of Witchger). Furthermore, if one were to substitute the cover (20) - terminal housing (21) of Sugiura et al for the Witchger tape, then there would be no Witchger tape to connect its ends together (the tape would then be superfluous).

At page 4 of the Answer, the Examiner argues, also as to claim 3, that it would have been obvious to use the coil assembly of

Witchger, as modified, in conjunction with the cover in a ballast for the purpose of protecting a ballast winding from external contamination. Contrary to the Examiner's remark on contamination, the basic purpose of the claimed cover is the need for good electric insulation in an electric ballast. This is so because, during lamp ignition, high voltage peaks occur and it is important that the coil base and the cover cooperate to enclose the coil windings as much as possible so as to provide good insulating characteristics for the electric ballast. The claimed invention does not aim to prevent contamination. The Answer does not make out a prima facie case of obviousness as to claim 3 since it is factually deficient (e.g. invalid motivation).

Turning to the "103" rejection of claim 4, if the Sugiura et al cover (20) with terminal housing (21) was substituted for the Witchger tape (31), it is not seen how one could connect end portions of the Sugiura et al cover (20) to each other, much less by means of one or more snap connections, as claimed in claim 4 of this application. Furthermore, Applicant submits that snap connections are not known in the art of electric ballasts, and especially not known is the idea of forming the insulating cover connection to itself as a snap connection.

The Examiner's statements in Sections [8] and [9] of paragraph (11) of the Answer appear to assume that his proposed combination still includes the strip tape (31) of Witchger, but this would not be so since such tape would not be required, and in fact would be superfluous, if the Witchger apparatus was modified to use the cover (20) - terminal housing (21) of Sugiura et al. Sections [8]

and [9] of paragraph (11) of the Answer are based upon a false premise and are therefore without merit.

The Examiner's proposed combination of Witchger, Sugiura et al and Leach et al (USP 4,363,014) would not be obvious, but even if it were, it would not result in the novel and useful electric ballast as claimed in claim 4.

For all of the above reasons, and those presented in the main appeal brief, the Final Rejection should be reversed and claims 3-5 should be allowed.

Respectfully submitted,

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July 10, 2001

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